



DEPARTMENT OF COMMERCE

[3510-16]

Patent and Trademark Office

37 CFR Parts 2 and 7

Docket No. PTO-T-2010-0073

RIN 0651-AC49

Changes in Requirements for Specimens and for Affidavits or Declarations of Continued Use or Excusable Nonuse in Trademark Cases

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: In order to help assess and ensure the accuracy of the trademark register, the United States Patent and Trademark Office (“USPTO”) is revising the Trademark Rules of Practice and the Rules of Practice for Filings Pursuant to the Madrid Protocol to allow the USPTO to: upon request, require any additional specimens, information, exhibits, and affidavits or declarations deemed reasonably necessary to examine a post registration affidavit or declaration of continued use or excusable nonuse in trademark cases, and for a two-year period, conduct a pilot program for the USPTO to assess the accuracy and integrity of the register; and upon request, require more than one specimen in connection with a use-based trademark application, an allegation of use, or an amendment to a registered mark. These revisions aim to ensure the ability to rely on the trademark register as an accurate reflection of marks that are actually in use in the United States for the goods/services identified in the registration, and thereby reduce costs and burdens on the public.

DATES: This rule is effective on [Insert date 30 days from the date of publication in the Federal Register].

FOR FURTHER INFORMATION CONTACT: Contact Cynthia C. Lynch, Office of the Deputy Commissioner for Trademark Examination Policy, by telephone at (571)272-8742.

SUPPLEMENTARY INFORMATION:

General Information

To benefit the public, the USPTO is revising the Trademark Rules of Practice (37 CFR Part 2) and the Rules of Practice for Filings Pursuant to the Madrid Protocol (“Madrid Rules”) (37 CFR Part 7) to allow the USPTO to: (1) upon request, require any specimens, information, exhibits, and affidavits or declarations deemed reasonably necessary to examine a post registration affidavit or declaration of continued use in trademark cases, and assess the accuracy and integrity of the register; and (2) upon request, require more than one specimen in connection with a use-based trademark application, an allegation of use, or an amendment to a registered mark.

The revisions will facilitate the USPTO’s ability to verify the accuracy of identifications of goods/services. The accuracy of the trademark register as a reflection of marks that are actually in use in the United States for the goods/services identified in the registration serves an important purpose for the public. The public relies on the register to clear trademarks that they may wish to adopt or are already using. Where a party searching the register uncovers a similar mark, registered for goods or services that may result in confusion of consumers, that party may incur a variety of resulting costs and burdens, such as changing plans to avoid use of the mark,

investigative costs to determine how the similar mark is actually used and assess the nature of any conflict, or cancellation proceedings or other litigation to resolve a dispute over the mark. If a registered mark is not actually in use in the United States, or is not in use on all the goods/services recited in the registration, these types of costs and burdens may be incurred unnecessarily. Thus, accuracy and reliability of the trademark register help avoid such needless costs and burdens, and thereby benefit the public.

Specimens of use in use-based trademark applications illustrate how the applicant is using the proposed mark in commerce on particular goods/services identified in the application. Post registration affidavits or declarations of use and their accompanying specimens demonstrate a trademark owner's continued use of its mark in commerce for the goods/services in the registration. As part of a pilot program to assess the accuracy of the identifications of goods/services of currently registered marks, the USPTO anticipates issuing requirements for additional proof of use in conjunction with the review of post-registration maintenance filings for approximately 500 registrations.

Background

On April 26, 2010, the USPTO and the George Washington University Law School hosted a roundtable discussion on the topic of "The Future of the Use-Based Register." Panelists and audience members explored the implications of the decision of the Court of Appeals for the Federal Circuit in *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009), clarifying the high standard for fraud on the USPTO in connection with trademark cases.

A "brainstorming" session at the conclusion of the roundtable resulted in a list of suggestions for how to improve the accuracy of identifications of goods/services. These suggestions were not focused on fraud, as was the *Bose* decision, but rather on the accuracy of the register. Several participants made the suggestion that the USPTO require additional specimens, or a specific type of proof of use of a mark, for all, or more than one, of the identified goods/services. Such additional requirements could help provide information regarding the extent to which a problem with inaccuracy exists on the register, and could help discourage inaccuracies.

The Trademark Act gives the Director discretion regarding the number of specimens to require (15 U.S.C. 1051(a)(1), (d)(1), 1058(b)(1)(C), 1141k(b)(1)(C)). Moreover, it requires applicants to comply with rules as prescribed by the Director (15 U.S.C. 1051(a)(4), (b)(4)). Additionally, the Director and USPTO may establish regulations governing the conduct of proceedings in the Office (15 U.S.C. 1123, 35 U.S.C. 2(b)(2)(A)). The current Trademark Rules of Practice and Madrid Rules mandate the submission of one specimen per class in connection with use-related filings (37 CFR 2.34(a)(1)(iv), 2.56(a), 2.76(b)(2), 2.86(a)(3), 2.86(b), 2.88(b)(2), 2.161(g), 7.37(g)). Similarly, the current rules require one specimen to be submitted in connection with an amendment to a registered mark (37 CFR 2.173(b)(3)). In addition, although the current Trademark Rules of Practice allow the USPTO to require additional information or exhibits deemed reasonably necessary to the examination of a pending application (37 CFR 2.61(b)), no counterpart rule exists in the post registration context to facilitate proper examination of an affidavit or declaration of continued use or excusable nonuse.

To ensure that the USPTO may properly examine affidavits or declarations, and the nature and veracity of the use claimed therein, additional specimens or other information or exhibits, such as a photograph of the mark appearing on certain goods, may be needed. Accompanying affidavits or declarations to verify information or exhibits may also be needed. One purpose of the final rule is to allow the USPTO to require trademark applicants or registrants to submit any additional specimens or other information, exhibits and affidavits or declarations reasonably necessary for proper examination. A second purpose of the rule is to allow the USPTO to conduct a limited-duration post registration pilot program to verify the accuracy of claims that a trademark is in use on particular goods/services, as a means to assess and improve the accuracy and integrity of the register. The rule does not focus on fraud issues, but only on the more general concern with ensuring accuracy. A third purpose of the rule is to harmonize the requirements that can be made as part of the examination of use allegations made in post registration maintenance documents with the requirements currently authorized in the examination of use allegations made prior to registration.

Proposed Rule and Request for Comments

A proposed rule was published in the Federal Register on July 12, 2011, at 76 FR 40839, and in the Official Gazette on August 9, 2011. The USPTO received comments from six intellectual property organizations and four attorneys and/or law firms. These comments are posted on the USPTO's Web site at http://www.uspto.gov/trademarks/law/comments_requirements_for_specimens_or_evidence.jsp, and are addressed below.

References below to “the Act,” “the Trademark Act,” or “the statute” refer to the Trademark Act of 1946, 15 U.S.C. 1051 *et seq.*, as amended. References to “TMEP” or “*Trademark Manual of Examining Procedure*” refer to the 8th edition, October 2011.

General Comments

Comment: Five commenters expressed support of the USPTO’s efforts to ensure the accuracy of the trademark register but expressed concern regarding the lack of more specific criteria signaling when and to what extent an owner might expect a request for additional evidence, specimens, or information under the rule changes. Two commenters speculated that the only way an owner might mitigate these concerns would be to preemptively submit additional specimens in all filings; and another commenter noted that, without further guidelines, the rules could be implemented to create an unfair burden on certain trademark owners.

Response: The USPTO appreciates the commenters’ support of the general objective of the rule changes, namely, requiring additional evidence or specimens to allow the USPTO to assess the accuracy and integrity of the register. The USPTO initially intends to accomplish this objective by conducting a pilot in which approximately 500 trademark registrations for which Section 8 or 71 affidavits are being filed will be randomly selected to receive an Office action requiring proof of use of the mark on two additional goods/services per class. If the owner is unable to provide the requested proof of the mark appearing on or in connection with the specified goods/services, those goods/services in question will be deleted from the registration, and the Section 8 or 71 affidavit will be subject to further review.

Because the USPTO and stakeholders initially desire information about the level of accuracy of the register, rather than assuming that widespread inaccuracies exist, the rules permit the USPTO to randomly select for the pilot from among all types of registrations. This will ensure that the resulting assessment is not skewed by consideration of registrations with particular criteria, and that implementation of the rules does not create an unfair burden on specific types of trademark owners.

Contrary to the suggestion by some commenters, owners need not submit additional specimens with all Section 8 or 71 affidavits. The approximately 500 registrations selected to participate in the two-year pilot represent less than 1% of the total number of affidavits usually processed during a typical six-month period. Moreover, owners of the registrations selected will be afforded the usual post registration response period to the Office action requiring additional information.

To address concerns regarding the long-term impact of the rule changes beyond the pilot, the USPTO is amending the rulemaking to indicate that the language authorizing the USPTO to assess the accuracy and integrity of the register will expire two years after the effective date of the final rules on Section 8 and 71 affidavits. This “sunset provision” allows the USPTO the necessary authority to randomly sample Section 8 and 71 affidavits in order to conduct the pilot. Upon expiration of the two-year period, additional specimens and information may be requested when the USPTO deems it reasonably necessary for examination of a particular Section 8 or 71 affidavit. The USPTO is eliminating from the final rulemaking other provisions included in the proposed rule which would have authorized requests for additional specimens and information to

assess the accuracy and integrity of the register both prior to registration and in connection with a Section 7 amendment to a registration. In those contexts, the final rules provide that the USPTO may request additional specimens and information only when reasonably necessary for examination. Therefore, although the USPTO is sunsetting its authority to ask randomly for additional specimens and information, it is maintaining authority to probe accuracy when reasonably necessary for proper examination of a particular application or registration.

Comment: Due to the potential burden on trademark owners and broad discretion given to examiners, three commenters suggested a targeted approach in determining when the USPTO would request additional specimens. One commenter requested a provision in the rules or TMEP that the USPTO only require additional specimens on special occasions; for example, where identifications include a large number of, or significant disparity in, goods or services, and that the standards for requiring additional specimens for house marks be relaxed as compared to other identifications.

Another commenter suggested that specific guidelines be enacted to direct the exercise of discretion in requesting additional specimens. For example, an examiner should be required to identify some other fact-based reason, beyond the number of goods or services in an application, to justify a request for additional specimens, such as where a Web site does not show use of a mark with all goods or services. Moreover, the TMEP should be revised to include specific guidelines for when an examiner can request additional specimens.

A third commenter suggested that in order to achieve the desired result of a more accurate register, implementation of the proposed rules should be accompanied by guidance

describing instances in which additional evidence can be required. The commenter suggested that applications and registrations be flagged for heightened scrutiny and additional specimens or evidence of use if they use class headings in the identification, include unrelated and unlikely goods within a class, use multiple languages on packaging, include a lengthy list of related goods or services, or encompass alphabetically arranged “data dumps” from the ID manual.

Response: The USPTO determined that its objective of assessing the accuracy and integrity of the register could be better reached by randomly selecting the registrations chosen to participate in the pilot rather than targeting a specific subset of registrations. While the USPTO concurs that in the long term, a “targeted” approach may be appropriate, an initial assessment of a wide cross section of all types of registrations will best determine appropriate criteria for targeting. The limited nature of the pilot and “sunset provision” are geared to alleviate concerns regarding potential burdens to trademark owners. The USPTO has opted to initially request proof of use for two additional goods/services per class for registrations selected for the pilot. Thus, the potential burden will not be greater on trademark owners with particular types of registrations, including those for house marks or with lengthy identifications.

Comment: One commenter requested clarification whether trademark owners would face additional fees and surcharges for supplemental filings required under the new rules. The commenter noted that it was unclear whether a response to a request for additional evidence must be completed according to the same timeline as other responses and if an owner would need to pay a deficiency surcharge for a deficiency that did not exist until the request.

Response: No additional fees or surcharges will be required under the new rules.

Owners must respond to an Office action requiring additional information or specimens within six months of the issuance date of the Office action, or before the end of the relevant filing period for the Section 8 or 71 affidavit, whichever is later (37 C.F.R. 2.163(b), 7.39(a)).

Although such an Office action may address other items unrelated to the pilot program, and those other items may trigger a deficiency surcharge, a request under the new rules pertaining to the pilot would not be considered a deficiency requiring an additional fee.

Comment: One commenter expressed that typical trademark file histories are “too skimpy” with respect to specimens. The commenter further explained that advances in technology, and the USPTO’s information technology, have made it easier for trademark owners to submit photographs for specimen use. The commenter, therefore, suggested that specimens be required for each good or service, along with liberal correction of the specimen record. The commenter additionally expressed his preference for a date of use to be listed for every good and service so that priority of use is easier for the public to check.

Response: The USPTO appreciates the commenter’s support of its on-line resources. In order to mitigate the potential burden on trademark owners, the USPTO has opted to initially request proof of use for only two additional goods/services per class from participants in the pilot. Failure to provide such proof may result in a further request for additional information or specimens. The results of the pilot will help the USPTO to assess the accuracy and integrity of the register and whether and to what extent it may be necessary to request additional information or specimens on a more routine basis to ensure the accuracy of a registration.

Currently, the USPTO requires dates of use for each class of goods and services. There must be at least one specified item in each class to which the specified dates pertain (37 CFR 2.34(a)(1)(v), 2.76(c), 2.88(c); TMEP section 903.08). It is longstanding Office practice not to require dates of use for each good or service since it would be cumbersome for applicants to designate the dates for each item individually (TMEP section 903.08).

Comment: Another commenter stated that especially in cases where a lengthy identification triggers a requirement for additional information, examination of the accuracy of a claim of use should focus on ensuring the registration accurately reflects the goods or services for which the mark is used, based on all evidence that can be supplied, and not be an exercise designed to delete goods or services from registrations based on a “hyper-technical” analysis of specimens. Trademark owners should not lose rights in marks used in commerce because producing formal specimens can be burdensome, costly, and time-consuming. Deleting such goods and services from a mark in use would detract from, rather than improve, the accuracy of the register.

The commenter, therefore, suggested that the USPTO accept evidence of use that is reasonably sufficient to confirm the accuracy of the list, rather than determining if the evidence qualifies as a formal specimen. Acceptance of this evidence would be a practical way of determining that the claim of use is accurate without imposing an undue burden on trademark owners or an undue allocation of USPTO resources to the examination of additional specimens.

Moreover, the commenter noted that the USPTO’s examination of the additional evidence supplied in response to an information inquiry should apply a reasonable standard as to

whether the mark on the specimen agrees with the drawing, consistent with recent TTAB decisions and the more forgiving standard applied post registration.

A second commenter similarly proposed that a formal specimen is not necessary to ensure proper examination of claims of use and to assess the possibility of over-claiming. The commenter noted that goods and services should not necessarily be considered improperly included in a claim of use because specimens fail to satisfy rigorous formal requirements as to their sufficiency.

Response: As noted above, in order to assess the accuracy and integrity of the register, the USPTO intends to conduct a pilot in which approximately 500 trademark registrations will be randomly selected to submit proof of use for only two additional goods/services per class in response to an Office action issued after a Section 8 or 71 affidavit is reviewed by the USPTO. Registrations will not be selected for the pilot program's additional inquiry based on either the length or content of the identification in the registration. Instead, the incomplete nature of a trademark owner's response to the initial request for additional information will determine whether further inquiry is necessary. The limited nature of the pilot, in terms of duration, number of registrations impacted, the random selection of registrations for participation, and the amount of additional proof or specimens required, is intended to alleviate concerns regarding the potential burden to trademark owners.

The additional information or specimens will be reviewed according to the generally accepted standards for use in commerce. The USPTO finds no basis to establish a different, less formal, standard for use of the mark in commerce in the context of the pilot, and believes such a

distinction would be a disservice to the public. Not only would a new standard for determining what constitutes acceptable use in commerce increase public confusion, but it would also call into question whether a mark is actually used with particular goods or services. The USPTO notes that there is a uniform standard for determining what constitutes an acceptable specimen both prior to and post registration.

Comment: A comment noted that additional specimens or evidence of use should not be required to support identifications that appear in the USPTO ID Manual, even if the particular identification encompasses numerous products, such as “cosmetics” or “furniture.” Evidence of use of the mark on a single product should be sufficient to support inclusion of the phrase in the identification of goods or services.

Response: In conducting the pilot to assess the accuracy and integrity of the register, the USPTO will request that pilot participants submit proof of use for only two additional goods/services per class, with each demonstrating use for a different good or service in the identification. Even if a good or service within an identification is broadly defined, the USPTO will only require one specimen or other proof to demonstrate use for that particular good or service.

Discussion of Rule Changes

The USPTO is amending §§ 2.34(a)(1)(iv), 2.56(a), 2.76(b)(2), 2.86(a)(3), 2.86(b), and 2.88(b)(2) to indicate that the USPTO may, upon request, require more than one specimen, including more than one specimen per class, if the USPTO deems additional specimens reasonably necessary to examine the application or allegation of use. These revisions codify

existing practice, where such additional specimens occasionally are requested under § 2.61 as information or exhibits necessary to examination. The Trademark Act gives the Director discretion regarding the number of specimens to require (15 U.S.C. 1051(a)(1), (d)(1)). The USPTO is additionally amending the final rule for § 2.56(a) to substitute the wording “or services” for “or in the sale or advertising of the services in commerce” to be consistent with the language in § 2.173(b)(3), and adding the wording “as reasonably necessary to proper examination” to be consistent with the language in § 2.61(b).

Comment: One commenter stated that requiring applicants and registrants to submit additional specimens is not burdensome, especially in comparison to the exclusive rights and evidentiary presumptions granted to trademark owners and the benefits of an accurate trademark register. The commenter further noted that in the digital age, the costs of obtaining and submitting additional specimens are negligible when the goods or services are being used in commerce as required. The commenter additionally stated that thorough training by the USPTO should mitigate concerns regarding the additional discretion given to examiners and describe with particularity the types of situations where additional specimens may be required. The commenter, therefore, expressed strong support for the rule changes because of the benefits obtained from a more accurate register and relatively small burdens on applicants and registrants. The commenter also noted that further study regarding the amount of “deadwood” on the U.S. trademark register would be valuable to all stakeholders in the trademark community.

Response: The USPTO appreciates the commenter’s support of the rule changes and agrees that the public will greatly benefit from an accurate trademark register. As the commenter

suggests, the USPTO intends to continue to provide internal and external guidance to mitigate concerns regarding USPTO discretion and provide examples of when additional specimens may be required.

The USPTO is amending § 2.61(b) to indicate that accompanying affidavits or declarations may be required along with information or exhibits. The wording “and such additional specimens” is added to the final rule to explicitly provide for specimen requests. The previously proposed provision that a requirement for additional information may issue, for the USPTO to assess the accuracy and integrity of the register, is not included in the final rule because the USPTO’s pilot program will focus exclusively on use allegations in post registration maintenance filings. The USPTO maintains its authority to probe accuracy when reasonably necessary for examination of a particular application.

Comment: Citing TMEP section 904.01(a) and current § 2.61(b), three commenters stated that in the context of pre-registration, examining attorneys already have authority to request additional specimens. Two commenters noted that it is unclear why the amendment to § 2.61(b) is necessary since authority to request additional specimens is already given under the current rule. The third commenter suggested that further guidance on the use of this authority can be provided through examination guides, rather than rule changes. One of the commenters expressed a lack of support for the changes to §§ 2.34, 2.56, 2.61, 2.76, 2.86, or 2.88.

Response: Because the current rule on specimens refers to only one specimen per class and the current rule on information requirements does not explicitly refer to specimens, in revising the rules, the USPTO deems it appropriate to provide explicitly for such specimen

requests. Specifically, the additional language allowing for “affidavits or declarations” to be required codifies existing practice, where additional evidence is requested, and explicitly clarifies that the USPTO may verify information or exhibits, when needed.

The additional previously proposed language allowing the USPTO to “assess the accuracy and integrity of the register” was deleted and is not included in the final rule because the USPTO’s pilot program will focus exclusively on use allegations in post registration maintenance filings. The USPTO maintains its authority to probe accuracy when reasonably necessary for examination of a particular application.

Comment: A commenter expressed concern that while the goal of amending § 2.61(b) may be to determine the extent to which over-claiming exists pre-registration, the changes to the rule may impact domestic applicants more than Section 44 or 66 applicants, who are not required to submit specimens prior to registration.

Response: Section 2.61(b) is used to require additional information and exhibits from all applicants prior to registration. Although it has occasionally been used as a means for requiring additional specimens, it is more commonly used as a means for examining attorneys to request literature, exhibits, and general information concerning the nature of the mark in order to allow for proper examination. *See* TMEP section 814. The additional previously proposed language allowing the USPTO to “assess the accuracy and integrity of the register” was deleted and is not included in the final rule. The USPTO maintains its authority to probe accuracy when reasonably necessary for examination of a particular application. The USPTO will conduct its

pilot to assess accuracy in connection with the filing of a Section 8 or 71 affidavit, since such filings are required of all trademark owners.

The USPTO is amending § 2.161(g) and § 7.37(g) to indicate that the USPTO may require more than one specimen in connection with the examination of the affidavit or declaration of continued use. For example, additional specimens may be requested in a case to verify the accuracy and the nature of the use when the identification includes a large number of, or significant disparity in, goods or services. The Trademark Act gives the Director discretion regarding the number of specimens to require (15 U.S.C. 1058(b)(1)(C), 1141k(b)(1)(C)).

The USPTO is adding § 2.161(h) and § 7.37(h) to provide that the USPTO may require such specimens, information, exhibits, and affidavits or declarations as the USPTO deems reasonably necessary to the proper examination of the affidavit or declaration of continued use, or for the USPTO to assess the accuracy and integrity of the register. These provisions are corollaries to § 2.61(b), which currently allows the USPTO to require additional information or exhibits in connection with the examination of a pending application. These provisions also clarify that accompanying affidavits or declarations may be required. The wording “and such additional specimens” is added to the final rule to clarify that the standards applicable to § 2.161(g) and § 7.37(g) are contained in § 2.161(h) and § 7.37(h). The provisions allowing the USPTO to assess the accuracy and integrity of the register will expire two years after the effective date of the final rule.

Comment: Noting that currently there is not a counterpart to § 2.61(b) that would enable the USPTO to request additional specimens post registration, three commenters expressed

support of implementing proposed § 2.161(h) and § 7.37(h) to the extent they conform to current § 2.61(b). Two of the commenters further noted that claims of use, post registration, for owners of registrations under Sections 44 and 66 should be examined under the same criteria applied to owners of use-based applications. One commenter further noted that they did not support the proposed changes to § 2.161(g) and § 7.37(g) since they did not conform to current § 2.61(b).

Response: The USPTO appreciates the commenters' support of the rule changes and agrees with the commenters regarding the importance of having post registration corollaries to § 2.61(b). Just as § 2.61(b) was amended to clarify that accompanying affidavits or declarations may be required, this same clarification was added to § 2.161(h) and § 7.37(h) in order to explicitly provide for the USPTO to verify information or exhibits, when needed. Similarly, the amendments to § 2.161(g) and § 7.37(g) were made in order to provide for the USPTO to request additional specimens.

The language in § 2.161(h) and § 7.37(h) allowing the USPTO to “assess the accuracy and integrity of the register” is for the limited purposes of the pilot explained above, and will expire two years after the effective date of the final rule. This “sunset provision” is intended to alleviate concerns regarding the burdens associated with discretionary requests for additional specimens and information to assess the accuracy and integrity of the register. The USPTO maintains its authority to probe accuracy when reasonably necessary for examination of a particular registration.

The USPTO agrees with the commenters that post registration claims of use should be examined under the same criteria regardless of the initial filing basis. The USPTO, therefore,

determined that the pilot assessing the accuracy and integrity of the register should be conducted with the filing of Section 8 or 71 affidavits, since such filings are required of all trademark owners.

Comment: Noting that a registration could include many goods and services, one commenter emphasized that submitting many specimens could be time-consuming and burdensome.

Response: As previously noted, the limited nature of the pilot and “sunset provision” are geared to alleviate concerns regarding potential burdens to trademark owners. As proof of use of the mark on only two additional goods/services per class will be required of participants in the pilot, the potential burden will not be much greater on trademark owners with registrations for many goods or services. Failure to provide the requested proof may result in further requests for proof as to additional goods/services in that registration.

Comment: Two commenters noted that prior to registration, if an applicant is unable to provide an acceptable specimen for a Section 1(a) use-based application, the applicant has the option of amending the applicable goods or services to a Section 1(b) intent-to-use basis. The commenters proposed, with a third commenter, that if a trademark owner is faced with a requirement for additional specimens post registration, the USPTO should allow the owner to voluntarily delete the goods or services, as an alternative to providing the specimens, without incurring vulnerability as to the remaining goods or services. This should not be viewed as an admission that the goods or services were improperly claimed in the initial filing as there are a number of reasons why trademark owners may opt not to provide additional evidence of use.

Similarly, one of the commenters noted that if goods or services are deleted from a registration following an information request, the remainder of the registration should not be vulnerable to challenge as to its validity. A commenter further stated that pre-registration for use-based applications, applicants should have the option of asserting a dual Section 1(b) basis for any goods or services subject to a requirement for additional specimens or evidence.

Response: When a trademark owner files a Section 8 or 71 affidavit, the trademark owner is asked to specifically verify if the mark is in use in commerce on or in connection with all of the goods or services listed in the registration. If the mark is not in use with all of the goods or services, the owner is asked to identify the goods or services to be deleted from the registration. Therefore, if a trademark owner is not using the mark with all of the goods or services listed in a registration, and excusable nonuse is not claimed, the goods should be voluntarily deleted from the registration upon the filing of the Section 8 or 71 affidavit as required by the Trademark Act, prior to the USPTO's request for additional information or specimens upon review of the Section 8 or 71 affidavit. As a reminder, 18 U.S.C. 1001 and 37 CFR 11.18 apply to submissions to the USPTO and impose an obligation of reasonable inquiry and truthfulness.

If a registration is selected to participate in the pilot assessing the accuracy and integrity of the register, the trademark owner may at that point voluntarily delete goods or services from its registration as an alternative to providing the additional information or specimens requested by the USPTO. Such a deletion will not trigger cancellation of the entire registration, but may subject the registration to a further information or specimen requirement by the USPTO to verify

the accuracy of the remaining goods or services claimed in the registration. Although the pilot will not apply to applications, applicants always have the option of relying on both Sections 1(a) and 1(b) in the same application, though the applicant may not assert both bases for identical goods or services in the same application. *See* TMEP section 806.02(b).

Comment: One comment noted that failure to provide requested information as to only a portion of the goods or services should not result in cancellation of the entire registration.

Response: The USPTO agrees with this comment and notes that when a registration is selected to participate in the pilot and an Office action issues requiring additional evidence or specimens, a response must be filed within six months of the Office action, or before the end of the filing period for the Section 8 or 71 affidavit, whichever is later (37 CFR 2.163(b), 7.39(a)). If a response is filed but fails to include the required evidence or specimens, the USPTO will deem the Section 8 or 71 affidavit unacceptable as to the goods or services to which the requirement pertained and delete them from the registration. Such a response may also trigger a further requirement for proof of use as to some or all of the remaining goods/services. However, assuming the Section 8 or 71 affidavit is otherwise acceptable, and any requested proof of use as to remaining goods/services is satisfied, the remaining goods/services will be unaffected. By contrast, if no response whatsoever to the Office action is filed within the response period, and no time remains in the statutory filing period, the registration will be cancelled (37 CFR 2.163(c), 7.39(b)). Thus, absent other issues with the affidavit, the registration will not be cancelled unless the owner fails to respond to the Office action or is unable to demonstrate use for any of the remaining goods or services in the registration.

Comment: Citing § 2.161 and § 7.37, an additional commenter indicated that the proposed rules providing for additional specimens could present an equal-protection issue due to their discretionary nature, noting that “when requested by the Office” is not a clear and definite standard.

Response: The Trademark Act gives the Director discretion regarding the number of specimens to require (15 U.S.C. 1051(a)(1), (d)(1), 1058(b)(1)(C), 1141k(b)(1)(C)). The revisions to §§ 2.34(a)(1)(iv), 2.56(a), 2.76(b)(2), 2.86(a)(3), 2.86(b), and 2.88(b)(2) to indicate that the USPTO may, upon request, require more than one specimen, including more than one specimen per class, if the USPTO deems additional specimens reasonably necessary to examine the application or allegation of use, codify existing practice, where such additional specimens occasionally are requested under § 2.61 as information or exhibits necessary to examination.

The revisions to § 2.161(g) and § 7.37(g) to indicate that the USPTO may require more than one specimen in connection with the examination of an affidavit or declaration of continued use are corollaries to the above-referenced pre-registration procedures when additional specimens are necessary to verify the accuracy and nature of the use. The standards applicable to § 2.161(g) and § 7.37(g) can be found in § 2.161(h) and § 7.37(h). Both subsections have been revised to explicitly provide that the USPTO may require specimens, information, exhibits, and affidavits or declarations as “reasonably necessary” for examination or “to assess the accuracy and integrity of the register.” Because these standards are not impermissible or arbitrary, there can be no equal-protection violation. *Cf. In re Boulevard Entm’t, Inc.*, 334 F.3d 1336, 1343, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003) (noting that no USPTO equal-protection

violation could occur “unless the agency acted pursuant to some impermissible or arbitrary standard”).

Moreover, even regardless of standards, constitutional challenges have been rejected in the trademark-registration context where a determination not to register a mark does not foreclose use of that mark. *See In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1374, 31 USPQ2d 1923, 1928-29 (Fed. Cir. 1994); *In re McGinley*, 660 F.2d 481, 484, 211 USPQ 668, 672 (C.C.P.A. 1981).

The USPTO is amending § 2.173(b)(3) to clarify that where an amendment involves a change in the mark, a new specimen must be provided for each class in a multiple-class registration, and additional specimens may be required when necessary, and to add § 2.173(b)(4) to provide that the USPTO may require such specimens, information, exhibits, and affidavits or declarations as the USPTO deems reasonably necessary to the proper examination of the proposed amendment. The term “specimens” is added to § 2.173(b)(4) to clarify that the standards applicable to § 2.173(b)(4) are contained in § 2.173(b)(3). The previously proposed provision that a requirement for additional information may issue, for the USPTO to assess the accuracy and integrity of the register, is not included in the final rule.

Comment: Two commenters noted that because claims of use as to all goods and services are not at issue when a request for amendment of a registration is sought, they do not support the proposed changes to § 2.173.

Response: As claims of use as to all goods and services do not accompany amendments to registrations, the pilot to assess the accuracy and integrity of the register will be conducted

with the filing of mandatory Section 8 or 71 affidavits and not optional Section 7 amendments. The revisions to § 2.173(b)(3) clarify that where an amendment involves a change in the mark, a new specimen must be provided for each class in a multiple-class registration. This will allow the USPTO to assess that the amended mark is being used on or in connection with each class of goods or services in the registration. The addition of § 2.173(b)(4) similarly assists the USPTO by providing a means for additional information to be requested, as a post registration corollary to § 2.61(b). The additional previously proposed language allowing the USPTO to “assess the accuracy and integrity of the register” was deleted and is not included in the final rule.

Overview of the Pilot

As set forth above, the USPTO intends to conduct a two-year pilot program to verify the accuracy of post registration claims that a trademark is in use on particular goods/services. The USPTO will randomly select approximately 500 trademark registrations for which a Section 8 or 71 affidavit was filed and issue an Office action requiring proof of use of the mark on two additional goods/services per class. Although a declaration will be required to verify the proof of use, one declaration may support all the additional proof. The random selection will include all types of registrations and will represent less than 1% of the total number of affidavits usually processed during a typical six-month period.

Owners of the registrations selected for the pilot will be afforded the usual post registration response period to the Office action requiring additional proof of use and an accompanying standard declaration. Specifically, a response will be due within six months of the Office action, or before the end of the filing period for the Section 8 or 71 affidavit,

whichever is later (37 CFR 2.163(b), 7.39(a)). Specially trained senior attorneys will conduct the examination for the pilot, reviewing the proof of use according to the generally accepted standards for use in commerce. The assigned senior attorneys may address specific questions or concerns about particular cases. The USPTO also will establish a dedicated mailbox, TMPostRegPilot@uspto.gov for more general questions and concerns relating to the pilot.

If a response is filed but fails to include the required evidence or specimens, the USPTO will deem the Section 8 or 71 affidavit unacceptable as to the goods or services to which the requirement pertained and delete them from the registration. Such a response may also trigger a further requirement for proof of use as to some or all of the remaining goods/services. However, assuming the Section 8 or 71 affidavit is otherwise acceptable, and any requested proof of use as to remaining goods/services is satisfied, the remaining goods/services will be unaffected. By contrast, if no response to the Office action is filed within the response period, and no time remains in the statutory filing period, the registration will be cancelled (37 CFR 2.163(c), 7.39(b)).

After the conclusion of the pilot, the USPTO will share the results as a basis for further consideration and discussion of the level of accuracy of the register. The results of the pilot will help inform whether and to what extent it may be appropriate to request additional information or specimens on a more routine basis to ensure accuracy.

Rulemaking Requirements

Executive Order 12866: This rule has been determined not to be significant for purposes of Executive Order 12866.

Executive Order 13563: The Office has complied with Executive Order 13563. Specifically, the Office has: (1) used the best available techniques to quantify costs and benefits, and has considered values such as equity, fairness and distributive impacts; (2) provided the public with a meaningful opportunity to participate in the regulatory process, including soliciting the views of those likely affected prior to issuing a notice of proposed rulemaking, and provided on-line access to the rulemaking docket; (3) attempted to promote coordination, simplification and harmonization across government agencies and identified goals designed to promote innovation; (4) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (5) ensured the objectivity of scientific and technological information and processes, to the extent applicable.

Administrative Procedure Act: This rule merely involves rules of agency practice and procedure within the meaning of 5 U.S.C. 553(b)(A). *See Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), does not require notice and comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice”) (quoting 5 U.S.C. 553(b)(A)); *Inova Alexandria Hosp. v. Shalala*, 244 F.3d 342, 350 (4th Cir. 2001) (rules for handling appeals were procedural where they did not change the substantive standard for reviewing claims); *Bachow*

Commc'ns Inc. v. FCC, 237 F.3d 683, 690 (DC Cir. 2001) (rules governing an application process are procedural under the Administrative Procedure Act). Therefore, this rule may be adopted without prior notice and opportunity for public comment under 5 U.S.C. 553(b) and (c), or thirty-day advance publication under 5 U.S.C. 553(d).

However, the USPTO chose to seek public comment before implementing the rule and is providing thirty-day advance publication notice.

Regulatory Flexibility Act: The final rule involves rules of agency practice and procedure. As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 or any other law, neither a Regulatory Flexibility Act analysis nor a certification under the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*) is required. *See* 5 U.S.C. 603.

A Final Regulatory Flexibility Act Analysis (“FRFA”) of the final rule is not required; nevertheless, the USPTO has undertaken this FRFA to further describe the minimal effects on any small entities.

1. Description of the reasons that action by the Office is being undertaken:

The USPTO is requiring: (1) any specimens, information, exhibits, and affidavits or declarations deemed reasonably necessary to examine an affidavit or declaration of continued use in trademark cases; and (2) upon request, more than one specimen in connection with a use-based trademark application, an allegation of use, an amendment to a registered mark, or an affidavit or declaration of continued use in trademark cases.

These revisions will facilitate the USPTO's ability to verify the accuracy of identifications of goods/services. Specimens of use in use-based trademark applications illustrate how the applicant is using the proposed mark in commerce on particular goods/services identified in the application. Post registration affidavits or declarations of use and their accompanying specimens demonstrate a trademark owner's continued use of its mark in commerce for the goods/services in the registration.

2. Succinct statement of the objectives of, and legal basis for, the final rule:

The objective of the final rule is to facilitate the USPTO's ability to verify the accuracy of identifications of goods/services in trademark applications and registrations. The rule ensures that the USPTO may properly examine the nature and veracity of allegations of use made during the trademark application or post registration phase, and upon request, may require additional specimens or other information or exhibits, such as a photograph of the mark appearing on certain goods. Another purpose of the rule is to harmonize the requirements that can be made as part of the examination of use allegations made in post registration maintenance documents, which are currently more limited, with the requirements authorized in the examination of use allegations made prior to registration.

The Trademark Act gives the Director of the USPTO discretion regarding the number of specimens to require (15 U.S.C. 1051(a)(1), (d)(1), 1058(b)(1)(C), 1141k(b)(1)(C)). Moreover, it requires applicants to comply with rules as prescribed by the Director (15 U.S.C. 1051(a)(4), (b)(4)). Additionally, the Director and USPTO may establish regulations governing the conduct of proceedings in the Office (15 U.S.C. 1123, 35 U.S.C. 2(b)(2)(A)). The current Trademark

Rules of Practice and the Rules of Practice for Filings Pursuant to the Madrid Protocol mandate the submission of one specimen per class in connection with use-related filings (37 CFR 2.34(a)(1)(iv), 2.56(a), 2.76(b)(2), 2.86(a)(3), 2.86(b), 2.88(b)(2), 2.161(g), 7.37(g)). Similarly, the current rules require one specimen to be submitted in connection with a proposed amendment of a registered mark (37 CFR 2.173(b)(3)). In addition, although the current Trademark Rules of Practice allow the USPTO to require additional information or exhibits deemed reasonably necessary to the examination of a pending application (37 CFR 2.61(b)), no counterpart rule exists in the post registration context to facilitate proper examination of an affidavit or declaration of continued use or excusable nonuse.

3. Description and estimate of the number of affected small entities:

The USPTO does not collect or maintain statistics in trademark cases on small versus large entity applicants, and this information would be required in order to estimate the number of small entities that would be affected by the final rule. However, the USPTO believes that the overall impact of the rule on applicants and registrants will be relatively minimal.

The final rule applies to any entity filing a use-based trademark application and to any entity filing trademark registration maintenance filings or amendments. With respect to allegations of use in trademark applications, the rules merely codify existing practice, whereby the USPTO already occasionally requests additional specimens or other information under 37 CFR 2.61. Thus, because no change in practice will result from the rules in this regard, they will have no impact in the trademark application context.

After registration, registrants must make periodic filings with the USPTO to maintain their registrations. A Section 8 or 71 affidavit of continued use is a sworn statement that the mark is in use in commerce, filed by the owner of a registration (15 U.S.C. 1058, 1141k). The purpose of the Section 8 or 71 affidavit is to facilitate the cancellation of registrations for marks no longer in use. With respect to post registration maintenance filings, the Office estimates that only a small subset of trademark owners will be required to provide more than one specimen, or information or exhibits in connection with a Section 8 or 71 affidavit. The USPTO is unable to estimate what subset of the owners will be small entities impacted by the rules. In Fiscal Year 2011, 114,808 Section 8 or 71 affidavits were filed.

4. Description of the reporting, recordkeeping, and other compliance requirements of the final rule, including an estimate of the classes of small entities which will be subject to the requirement and the type of professional skills necessary for preparation of the report or record:

The final rule imposes no new recordkeeping requirements on trademark applicants or registrants.

Regarding compliance with the final rule, as an initial matter, the USPTO does not anticipate that the rule will have a disproportionate impact upon any particular class of small or large entities. Any entity that has a registered trademark could potentially be impacted by the rule.

Based on additional comment from the proposed rule, the USPTO estimates that in those post registration cases where a requirement for additional information, exhibits, declarations, or specimens is issued, it will take one hour to comply.

While the statement of use is a similar type of filing to those at issue in the final rules applied in the post registration context, as the statement of use involves providing one or more specimens of use and an accompanying declaration, the compliance time for the final rules should be less. Under the final rules applied in the post registration context, the type of fact gathering and review of the nature and extent of the use of the mark that underlies a statement of use will already have occurred. Compliance with the requirement will only necessitate gathering and submitting the evidence to demonstrate what has already been assessed.

Assuming the mark is in use, as claimed, the compliance time involves the length of time to secure a specimen, exhibit (such as taking a digital photograph), information, or declaration, plus any time it takes an attorney to communicate with the client in order to obtain what is required and make the necessary filing with the USPTO. In reality, approximately one-third of applications are filed pro se. These applicants and registrants, therefore, will likely have a lower compliance time than the USPTO has estimated, which assumes the involvement of counsel. These rules do not mandate the use of counsel.

The Office does not estimate any change in compliance cost associated with the final rules with respect to allegations of use in trademark applications, since the USPTO's current practice already allows for this. The rule change merely codifies existing practice.

5. Description of any significant alternatives to the final rule which accomplish the stated objectives of applicable statutes and which minimize any significant economic impact of the rule on small entities:

The USPTO has considered whether and how it is appropriate to reduce any burden on small businesses through increased flexibility. The following options have been considered, but rejected, by the USPTO as ineffective.

The alternative of never requiring additional specimens or other information in connection with Section 8 or 71 affidavits or exempting small entities from such requirements would have a lesser economic impact on small entities, but would not accomplish the stated objective of verifying the accuracy of identifications of goods/services in trademark registrations. As set forth above, the USPTO will rely on the final rule to assess the accuracy of use allegations. This assessment may provide a better sense of whether significant problems may exist with the accuracy of identifications of goods and services. Thus, exempting small entities would prevent the potential consideration of all Section 8 or 71 affidavits for this purpose, and therefore, would not achieve the stated objective of verifying accuracy.

The stated objective of the final rule also facilitates the cancellation of any registrations for marks that are no longer in use, the policy underlying the statutory requirement for Section 8 or 71 affidavits. Exempting small entities from any possible scrutiny regarding use allegations would fail to reach non-use of marks by small entity owners, thereby failing to achieve the objective.

Other options to potentially lessen the impact on small entities have been rejected as ineffective. For example, the USPTO deems unnecessary extended time periods for small entity compliance because there appears to be no reason that compliance with the requirements in the rules would be more time-consuming for small entities, and because the USPTO's standard time period for responding to trademark Office actions allows sufficient time regardless of small entity status.

The USPTO deems any streamlined or simplified compliance mechanism for small entities unnecessary, given the ease of responding to trademark Office actions electronically. Thus, compliance will be as streamlined and simplified as possible for all affected entities. Moreover, where the objective is to verify the accuracy of a claim of use in an affidavit, the requirements of one or more additional examples of the manner of the claimed use, or of other information such as photographic proof already seem to be the least burdensome and complex way to achieve the objective. Additionally, the requirement for submissions in order to assess the accuracy and integrity of the register will expire two years from the effective date of the rule. Accordingly, these post registration requirements will not have a significant economic impact on small entities. Any more minimal requirement would not demonstrate use, and therefore, would not meet the objective to verify use claims.

Use of performance rather than design standards is not applicable to the final rulemaking because the USPTO is not issuing any sort of standard. Rather, the rules will require applicants and registrants to furnish evidence of use, rather than comply with a performance or design standard.

Finally, with respect to allegations of use in trademark applications, the final rules merely codify existing practice, whereby the USPTO already occasionally requests additional specimens or other information under 37 CFR 2.61. Thus, because no change in practice would result from the rules in this regard, any different treatment of small entities in this context would fail to meet the stated objective and likely would generate concern and confusion about a change in practice.

6. Identification, to the extent practicable, of all relevant Federal rules which may duplicate, overlap, or conflict with the final rule:

The final rule will not duplicate, overlap, or conflict with any other Federal rules.

Unfunded Mandates: The Unfunded Mandates Reform Act requires, at 2 U.S.C. 1532, that agencies prepare an assessment of anticipated costs and benefits before issuing any rule that may result in expenditure by State, local, and tribal governments, in the aggregate, or by the private sector, of \$100 million or more (adjusted annually for inflation) in any given year. This rule would have no such effect on State, local, and tribal governments or the private sector.

Executive Order 13132: This rule does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

Paperwork Reduction Act: This rule involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). An information collection request was submitted to OMB under control number 0651-0055 at the time of the Notice of Proposed

Rulemaking, and a pre-approval was given. Since that time no substantive changes to the burden have been made. Additionally, the agency will follow up with a change worksheet submission to make all the necessary burden estimate adjustments.

This rulemaking provides for the USPTO to require: (1) any specimens, information, exhibits, and affidavits or declarations deemed reasonably necessary to examine an affidavit or declaration of continued use or excusable nonuse in trademark cases, or for the USPTO to assess the accuracy and integrity of the register; and (2) upon request, more than one specimen in connection with a use-based trademark application, an allegation of use, or an amendment to a registered mark.

There is no fee impact for submission of specimens. Additional burden due to postage costs for paper submissions for the post-registration Office actions is estimated at \$90, for a total increase in fee burden by an estimated \$90. The agency estimates the following overall impact on burden: an increase of responses of 500; an increase in burden hours of 485; and an increase in burden hour costs of \$164,900.

Comments were invited on: (1) whether the collection of information is necessary for proper performance of the functions of the agency; (2) the accuracy of the agency's estimate of the burden; (3) ways to enhance the quality, utility, and clarity of the information to be collected; and (4) ways to minimize the burden of the collection of information to respondents.

In response to the first inquiry, whether the collection of information is necessary for proper performance of the functions of the agency, the USPTO received three comments.

Comment: One comment noted that based on the U.S. trademark system, the commenter could understand the contents of the revision, but the commenter indicated that the revision may contradict the Trademark Law Treaty prohibition against submitting evidence of use with a renewal application.

Response: Evidence of use, or excusable non-use, is not a requirement for renewal applications under Section 9, and therefore, the revision does not contradict the Trademark Law Treaty (15 U.S.C. 1059). To renew a registration under Section 9, the owner must submit the requisite fee with the signed renewal form (15 U.S.C. 1059). Evidence of use, or excusable nonuse, is separately required under Sections 8 and 71 between the fifth and sixth year anniversaries after registration and every ten years after registration, or with payment of an additional fee, during the six-month grace period that follows (15 U.S.C. 1058(a), 1141k(a)).

Comment: Another commenter expressed that the collection of additional specimens would ensure a more accurate register and thus benefits the public and brand owners.

Response: The USPTO appreciates the commenter's support of the rule changes and agrees with the commenter regarding the benefit of a more accurate register.

Comment: A third commenter agreed that collecting information regarding the accuracy of the marks on the trademark register is a necessary and proper performance of the USPTO's functions. The commenter noted that an up-to-date register reflecting marks that are actually in use would benefit everyone. The commenter further stated that the USPTO should ensure that the information is gathered consistently and without singling out any particular classes of applications, registrations, or mark owners.

Response: The USPTO appreciates the commenter's support of the information collection. In conducting the pilot, the USPTO will collect the information regarding the accuracy of marks on the register consistently, without singling out any particular classes of applications, registrations, or mark owners. The USPTO intends to ensure consistent information collection by having a small group of specially trained senior attorneys examine the registrations selected for participation in the pilot. As the USPTO also intends to randomly select the registrations examined in the pilot, no type of application, registration, or mark owner will be singled out.

Regarding the accuracy of the agency's estimate of the burden, comments were received from three parties.

Comment: One commenter noted that due to the limited nature of the rule changes, they will not affect the scope of pre-registration trademark searches; and costs will be incurred when attorneys submit the additional evidence required. The commenter additionally requested that foreign applicants be allowed to maintain broader identifications of goods and services when filing a new trademark application based on a home-country registration.

Response: The rule changes codify current pre-registration practice. The USPTO's pilot program will be conducted post registration, and the limited nature of the pilot will alleviate the potential burden on trademark owners. The rule changes will not affect the USPTO's standards for determining the acceptability of identifications of goods and services, which are applied to all applicants and registrants.

Comment: Another comment noted that the burden on applicants to produce additional specimens is not terribly significant in the age of electronic specimens and filings. The burden of producing additional specimens is far less than the burdens imposed on the public and trademark community from an inaccurate register. Any evidence required under the rule changes relates to something an applicant or registrant should possess or easily document in carrying out existing duties of confirming that goods and services are currently in use.

Response: The USPTO appreciates the commenter's support of the rule changes and concurs that the rule changes create minimal burdens on trademark owners.

Comment: A commenter on the time burden agreed that the time to actually submit specimens or additional evidence will likely be an hour, but stated that the time involved in making the request to a client and reviewing the client's responses will be substantially greater. For mark owners and their counsel, compliance time with the additional requirements may depend on factors such as whether the client is foreign or domestic, the degree of explanation necessary for the client, and the length of the identification. The commenter noted that the USPTO may help alleviate the burden by requiring only one additional specimen or minimal additional information, and by foregoing the need for verifications of the specimens or other information.

Response: The USPTO notes that the estimated time burden for Paperwork Reduction Act purposes is an average encompassing the response time for all trademark owners, taking into account that trademark owners comprise large and small entities, with and without counsel. The USPTO acknowledges that the compliance time for the pilot may be greater than the compliance

time for a typical post registration response, and based on the commenter's feedback, the USPTO has increased the estimated burden time for submissions under the pilot to an hour. While the USPTO concurs with the commenter that compliance time may be greater for larger, represented entities, the average also encompasses pro se owners, for whom the compliance time will likely be lower than the USPTO has estimated. The USPTO also notes that as trademark owners are already required to ascertain whether a mark is currently in use with all the goods/services in connection with the filing of a Section 8 or 71 affidavit, any additional requirement to provide proof of such use with select goods/services should not be unduly burdensome.

As an additional means of alleviating the potential burden to trademark owners, only approximately 500 registrations will be selected to participate in the pilot assessing the accuracy and integrity of the register. Moreover, only proof of use of two additional goods/services per class will be required of participants in the pilot. Although a declaration will be required to verify the proof of use, one declaration may support all the additional proof. Owners need not preemptively submit multiple specimens with all trademark filings since the approximately 500 registrations selected to participate in the pilot represent less than 1% of the total number of Section 8 and 71 affidavits processed during a typical six-month period.

In response to the third inquiry, whether there are ways to enhance the quality, utility, and clarity of the information to be collected, the USPTO received two comments.

Comment: One commenter suggested that the USPTO could publish more guidance as to when specimens are required and the type of specimens that are generally acceptable. The commenter additionally noted that the USPTO should provide guidance to both applicants and

examiners that specimens for goods that appear to be merely digital mock-ups may be insufficient.

Response: The USPTO intends to provide additional guidance for those trademark owners chosen to participate in the pilot and continue its efforts to provide both internal and external guidance, through the TMEP and examination guides, regarding the general acceptability of specimens. It is long-standing Office policy that a submission that appears not to be actually used in commerce is unacceptable as a specimen. See, e.g., TMEP sections 904.03(i) and 904.04(a) regarding beta Web sites and printers proofs.

Comment: Another comment stated that the USPTO should publicize the nature of the specimens and additional information that will be required to support requests for information under the rule changes. The commenter noted that loosening the restrictions on catalog submissions could assist mark owners requested to provide additional specimens. Moreover, the USPTO should clarify whether requests for additional information will apply to entire classes or specific goods or services within a class. If declarations will be required to support additional specimens, having a uniform format will help ensure higher-quality submissions. Additionally, ensuring uniform levels of inquiry for specimens during prosecution and post registration, and publicizing them in exam guides or the TMEP, would further the goal of an accurate trademark register. Having a particular contact person, or dedicated mailbox, for issues that arise would ensure that practitioners and USPTO employees receive consistent guidance. Lastly, the USPTO should share any statistics kept on the success of the new rule – such as the length of descriptions

routinely queried, percentage of applications or registrations queried, and statistics that suggest that “deadwood” on the register is an issue to be addressed.

Response: As noted above, in order to assess the accuracy and integrity of the register, the USPTO intends to conduct a pilot in which approximately 500 trademark registrations will be selected to receive a requirement to submit proof of use for two additional goods/services per class in response to an Office action issued after a Section 8 or 71 affidavit is reviewed by the USPTO. The additional proof will be reviewed according to the same general standards as specimens submitted with a Section 8 or 71 affidavit, with the standard Section 8 or 71 declaration language required to be submitted with the additional proof.

In order to ensure uniformity within the pilot, a small group of specially trained senior attorneys will conduct the examination of the registrations selected for participation in the pilot. The assigned senior attorney handling a particular case may address specific questions or concerns about the case. As suggested by the commenter, the USPTO will establish a dedicated mailbox for more general questions and concerns relating to the pilot. Moreover, the USPTO will share the results of the pilot in the context of further consideration as to whether “deadwood” on the register is an issue.

Regarding ways to minimize the burden of the collection of information to respondents, comments were received from two parties.

Comment: A commenter proposed additional emphasis by the USPTO to educate applicants, in advance, regarding proper specimens and the difference between use-based and intent-to-use applications. The commenter also suggested adding information and warnings on

the USPTO Web site and during the electronic application process explaining the types of specimens that may be acceptable. The commenter additionally expressed that the USPTO could suggest to applicants that they may be able to reduce the length of the application process by submitting additional specimens with their applications.

Response: The USPTO appreciates the commenter's suggestions regarding ways to educate the public regarding the trademark process. The USPTO has developed a series of "how-to" videos covering important topics and critical application-filing and registration-maintenance tips. One video entitled "Before You File" covers the different filing bases, while another video focuses exclusively on education about specimens. The videos can be accessed on the USPTO Web site at <http://www.uspto.gov/trademarks/process/TMIN.jsp>. The USPTO is continuously striving to improve its electronic systems and to provide helpful information and warnings to guide users throughout the trademark registration process, and provides a link to the instructional video accessed through the Trademark Electronic Application System ("TEAS") explaining what constitutes an appropriate specimen for a good or service. While applicants are always welcome to submit additional specimens, the USPTO only requires one specimen per class, but agrees that by submitting additional specimens, applicants may in certain circumstances reduce the length of the application process by reducing the need for Office actions requesting acceptable specimens.

Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to

the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

List of Subjects

37 CFR Part 2

Administrative practice and procedure, Trademarks.

37 CFR Part 7

Administrative practice and procedure, Trademarks, International Registration.

For the reasons stated in the preamble and under the authority contained in 15 U.S.C. 1123 and 35 U.S.C. 2, as amended, the USPTO amends parts 2 and 7 of title 37 as follows:

PART 2 - RULES OF PRACTICE IN TRADEMARK CASES

1. The authority citation for 37 CFR part 2 continues to read as follows:

Authority: 15 U.S.C. 1123, 35 U.S.C. 2, unless otherwise noted.

2. Amend § 2.34 by revising paragraph (a)(1)(iv) to read as follows:

§ 2.34 Bases for filing.

(a) ***

(1) ***

(iv) One specimen per class showing how the applicant actually uses the mark in commerce. When requested by the Office, additional specimens must be provided.

3. Amend § 2.56 by revising paragraph (a) to read as follows:

§ 2.56 Specimens.

(a) An application under section 1(a) of the Act, an amendment to allege use under § 2.76, and a statement of use under § 2.88 must each include one specimen per class showing the mark as used on or in connection with the goods or services. When requested by the Office as reasonably necessary to proper examination, additional specimens must be provided.

4. Amend § 2.61 by revising paragraph (b) to read as follows:

§ 2.61 Action by examiner.

(b) The Office may require the applicant to furnish such information, exhibits, affidavits or declarations, and such additional specimens as may be reasonably necessary to the proper examination of the application.

5. Amend § 2.76 by revising paragraph (b)(2) to read as follows:

§ 2.76 Amendment to allege use.

(b) ***

(2) One specimen per class showing the mark as actually used in commerce. When requested by the Office, additional specimens must be provided. See § 2.56 for the requirements for specimens; and

6. Amend § 2.86 by revising paragraphs (a)(3) and (b) to read as follows:

§ 2.86 Application may include multiple classes.

(a) ***

(3) Include either dates of use (see §§ 2.34(a)(1)(ii) and (iii)) and one specimen for each class, or a statement of a bona fide intention to use the mark in commerce on or in connection with all the goods or services specified in each class. When requested by the Office, additional specimens must be provided. The applicant may not claim both use in commerce and a bona fide intention to use the mark in commerce for the identical goods or services in one application.

(b) An amendment to allege use under § 2.76 or a statement of use under § 2.88 must include, for each class, the required fee, dates of use, and one specimen. When requested by the Office, additional specimens must be provided. The applicant may not file the amendment to allege use or statement of use until the applicant has used the mark on all the goods or services, unless the applicant files a request to divide. See § 2.87 for information regarding requests to divide.

7. Amend § 2.88 by revising paragraph (b)(2) to read as follows:

§ 2.88 Filing statement of use after notice of allowance.

(b) ***

(2) One specimen of the mark as actually used in commerce. When requested by the Office, additional specimens must be provided. See § 2.56 for the requirements for specimens; and

8. Amend § 2.161 by revising paragraph (g) introductory text and adding paragraph (h) to read as follows:

§ 2.161 Requirements for a complete affidavit or declaration of continued use or excusable nonuse.

(g) Include one specimen showing current use of the mark for each class of goods or services, unless excusable nonuse is claimed under § 2.161(f)(2). When requested by the Office, additional specimens must be provided. The specimen must:

(h) The Office may require the owner to furnish such information, exhibits, affidavits or declarations, and such additional specimens:

(1) As may be reasonably necessary to the proper examination of the affidavit or declaration under section 8 of the Act; or

(2) For the Office to assess the accuracy and integrity of the register.

(3) The provisions of paragraph (h)(2) of this section will no longer be applied after [Insert date 2 years and 30 days from the date of publication in the Federal Register].

9. Amend § 2.173 by revising paragraph (b)(3) and adding paragraph (b)(4) to read as follows:

§ 2.173 Amendment of registration.

(b) ***

(3) If the amendment involves a change in the mark: one new specimen per class showing the mark as used on or in connection with the goods or services; an affidavit or declaration under § 2.20 stating that the specimen was in use in commerce at least as early as the filing date of the amendment; and a new drawing of the amended mark. When requested by the Office, additional specimens must be provided.

(4) The Office may require the owner to furnish such specimens, information, exhibits, and affidavits or declarations as may be reasonably necessary to the proper examination of the amendment.

**PART 7 – RULES OF PRACTICE IN FILINGS PURSUANT TO THE PROTOCOL
RELATING TO THE MADRID AGREEMENT CONCERNING THE
INTERNATIONAL REGISTRATION OF MARKS**

10. The authority citation for 37 CFR part 7 continues to read as follows:

Authority: 15 U.S.C. 1123, 35 U.S.C. 2, unless otherwise noted.

11. Amend § 7.37 by revising paragraph (g) and adding paragraph (h) to read as follows:

§ 7.37 Requirements for a complete affidavit or declaration of continued use or excusable nonuse.

(g) Include a specimen showing current use of the mark for each class of goods or services, unless excusable nonuse is claimed under § 7.37(f)(2). When requested by the Office, additional specimens must be provided. The specimen must meet the requirements of § 2.56 of this chapter.

(h) The Office may require the holder to furnish such information, exhibits, affidavits or declarations, and such additional specimens:

(1) As may be reasonably necessary to the proper examination of the affidavit or declaration under section 71 of the Act; or

(2) For the Office to assess the accuracy and integrity of the register.

(3) The provisions of paragraph (h)(2) of this section will no longer be applied after [Insert date 2 years and 30 days from the date of publication in the Federal Register].

Date: May 15, 2012_____

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

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